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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,887	04/16/2001	Paola Lenti	1011-287	4551

7590

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EXAMINER

PIERCE, JEREMY R

ART UNIT	PAPER NUMBER
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1771

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DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/835,887

Applicant(s)

LENTI, PAOLA

Examiner

Jeremy R. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Amendment B has been filed on May 27, 2003 as Paper No. 6. Claims 10-14 have been cancelled. New claims 15-19 have been added and are currently pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 17 recites a woven and dyed wool felt material having anti-smearing properties. The specification does not teach what these anti-smearing properties are, or how the wool felt material is made to have them.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 17, what does "anti-smearing properties" mean? Does it mean the dye does not run off of the wool felt? Is it associated with stain-resistant properties? The Examiner will assume that "anti-smearing" is associated with being stain-resistant.

With regard to claim 18, starting at line 4, the claim recites "a bottom layer of a woven or non-woven material, a bottom of a fabric material suitable for coupling with a coupling male portion of a tearable strip means." The Examiner will assume that the first "bottom layer" should actually be the "top layer" in accordance with the rest of the claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 15, 16, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Bender et al. (U.S. Patent No. 4,263,727).

Bender et al. disclose a web of natural or synthetic fibers that is flame-laminated to closed-cell polyolefin foam (column 1, lines 31-35) without the use of adhesive (column 2, lines 31-33). In a preferred embodiment, polyethylene foam is used and an upper layer of woven cotton fabric is additionally added (column 2, lines 62-68). Either fabric layer in the laminate would be suitable for attachment to a male coupling portion

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of a tearable strip means because fabric layers, in general, couple to male portions of tearable strip means.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bender et al. in view of Latzke (U.S. Patent No. 4,887,368) and further in view of Dessaint et al. (U.S. Patent No. 4,295,976).

Bender et al. disclose the top layer can be a woven cotton fabric (column 2, line 65), but do not disclose it to be a woven wool fabric that is dyed and has anti-smearing properties. Latzke discloses that woven wool, as well as woven cotton can be used as a skin compatible layer in a shoe insole (column 7, lines 42-46). It would have been obvious to one having ordinary skill in the art to use woven wool as the top layer in the insole of Bender et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. It would also have been obvious to dye the wool fabric any desired color for use as a shoe insole. However, neither Bender et al. nor Latzke disclose anti-smearing properties. Dessaint et al. disclose that a stain resistant property may be imparted onto textile fabrics, including woven and nonwoven articles of cotton

and wool (column 7, lines 36-45). It would have been obvious to one having ordinary skill in the art to add a stain-resistant agent to the top layer of Bender et al. in order to improve the insole by making it less likely to stain, as taught by Dessaint et al.

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bender et al. in view of Cohen (U.S. Patent No. 4,187,621).

Bender et al. do not disclose that the shoe insole is contour molded and cut. Cohen teaches an insole for shoes where the layers are flame-bonded together and then cut and conformed in contour with various thickness (Claim 1). It would have been obvious to one having ordinary skill in the art to use the method of forming a shoe insole disclosed by Cohen in the insole of Bender et al. in order to create a shoe insole that better fits the wearer's foot.

Response to Arguments

11. Applicant's arguments with respect to claims 15-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (703) 605-4243. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jeremy R. Pierce
Examiner
Art Unit 1771
June 24, 2003


ELIZABETH M. COLE
PRIMARY EXAMINER